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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,655	07/20/2001	John E. Liebendorfer	2164.004	2619

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EXAMINER

KING, ANITA M

ART UNIT	PAPER NUMBER
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3632

DATE MAILED: 09/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/910,655

Applicant(s)

LIEBENDORFER, JOHN E.

Examiner

Anita M. King

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-10,12-32 and 34-49 is/are pending in the application.
- 4a) Of the above claim(s) 24-30 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 38 and 44-49 is/are allowed.
- 6) ☒ Claim(s) 1,3-10,17-19,21,31,32,34,37,39 and 41-43 is/are rejected.
- 7) ☒ Claim(s) 5,12-16,20,22,23,35,36 and 40 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 July 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

This is the fourth office action for application number 09/910,655, System for Removably and Adjustably Mounting a Device on a Surface, filed on July 20, 2001.

### ***Election/Restrictions***

Claims 24-30 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on Paper No. 5, dated August 26, 2002.

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the features of claim 7, i.e., the flanges 44a, 44b of the duct clamp being perpendicular and not parallel as shown by Figure 10, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate

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changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

The disclosure is objected to because of the following informalities: on page 9, lines 1 and 24 a reference number is missing after "Figure" and reference character "68" is used for a connecting base, on page 9, line 25 and a device on page 9, line 27

Appropriate correction is required.

### ***Response to Amendment***

The indicated allowability of claims 11 and 19 is withdrawn in view of the newly discovered reference(s) to Byers. Rejections based on the newly cited reference(s) follow.

### ***Cancellation of Claims***

Claims 2, 11, and 33 have been canceled per applicant's request in correspondence dated, June 28, 2004.

### ***Claim Objections***

Claim 40 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The subject matter in claim 40 is redundant, this subject matter is cited in claim 38, from which claim 40 indirectly depends.

Claims 3 and 4 are objected to because of the following informality: claim 3 currently depends for canceled claim 2, for examination purpose, it will be assumed that applicant intended claim 3 to depend from claim 1. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 3-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not teach how the at least two tracks are removably mountable on the footing grid, however, the specification does teach how the rail is removably mountable on the footing grid (page 10, line 9).

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 39-43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 39 has ambiguous claim terminology where it is unclear whether latter recitations of originally cited terminology are intended to refer to the originally cited terms. It is unclear if "means for variably positioning the at least one dual track rail on the at least one keeper," bridging lines 2 and 3 of the claim is intended to refer to the original recitation of the term "means for variably positioning the one or more clamps in the hollow chamber," bridging lines 9 and 10 of claim 38.

### ***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 3, 4, 6-10, 17-19, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,957,568 to Byers. Byers discloses a system for removably and adjustably mounting a device (30) on a surface, comprising: a rail (10, 40) formed with at least two tracks (14, 16, 52); wherein the at least two tracks are removably mountable on a footing grid; a plurality of keepers (80, 104) on which to mount *the at least two tracks*; wherein the at least two tracks include a channel extending the length of the rail; one or more clamps (64, 74, 102) for connecting; wherein the channel in the

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at least two tracks is formed with a slot extending the length of the rail; wherein the slot is formed at substantially right angle to the slot in any other of the at least two tracks (the slot of track 52 is formed at a right angle to the slots of tracks 14 and 16); wherein the one or more clamps is formed as a duct with at least two opposing flanges; wherein the opposing flanges of the one or more clamps are substantially perpendicular to one another (see Fig. 10); wherein the one or more clamps is formed with a leg having a base (112), a descending member (below reference number 116) monolithically extending from the base, and an ascending member (110) monolithically extending from the base in a direction substantially opposite the direction of the descending member; wherein the one or more clamps included means for connecting the device to the rail; wherein the one or more clamps is formed with a plate and monolithic opposing side walls extending substantially in the same direction at substantially right angles to the plate; wherein the opposing side walls include a lower inner edge and an upper face, and a fin extending from the upper face substantially along the longitudinal axis of the at least one dual track rail; and wherein the one or more clamps includes means for variably positioning the one or more clamps.

Claims 31, 32, 34, and 37 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,349,912 to Schauss et al., hereinafter, Schauss. Schauss discloses a system for removably and adjustably mounting a device on a surface, comprising: a rail (1) formed with at least two tracks; wherein the at least two tracks include a slot formed at substantially a right angle to the slot in any other of the at least two tracks; wherein the rail is formed with a body having a proximal end, a distal end,

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and hollow chamber therebetween; one or more clamps (2) for connecting the system to the surface; wherein the at least two tracks includes a channel extending the length of rail; wherein the one or more clamps is formed as a duct with at least two opposing flanges; and wherein the one or more clamps is formed with a leg having a base, a descending member monolithically extending from the base, and an ascending member monolithically extending from the base in a direction substantially opposite the direction of the descending member.

### ***Allowable Subject Matter***

Claims 12-16, 20, 22, 23, 35, and 36 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 39 and 41-43 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claims 38 and 44-49 are allowed.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent 4,266,384 to Orals et al.

U.S. Patent 5,855,342 to Hawkins et al.




U.S. Patent 6,170,212 to Suchyna et al.

U.S. Patent 6,561,117 to Kell

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anita M. King whose telephone number is (703) 308-2162. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leslie A. Braun can be reached on (703) 308-2156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Anita M. King  
Primary Examiner  
Art Unit 3632

September 7, 2004